maintained by the database" with – read or download a copy --.

Page 11, line 30, replace "correlate" with – correlates --.

Page 13, line 11, replace "if" with – in --.

RESPONSE

Declaration

The Examiner asserts that the oath or declaration is defective for lack of the post office address of each inventor. Enclosed with this response is a copy of the declaration and power of attorney filed in this case along with the certificate of mailing for this document certifying that it was mailed to the Patent Office on April 26, 1999. On page three of the declaration the residence address of each inventor is shown, along with the zip code.

Claims

The Examiner has rejected claim 47 as anticipated by Kiraly. Element (b) of claim 47 specifies a step of providing to a client computer across a network from a server computer a work of authorship and, associated with said work, a hot spot. The specification states on page three lines 9 – 12 that a "hot spot" is something that is incorporated into a viewable image transmitted to the user. The Examiner asserts that the limitation of a hot spot in element (b) of claim 47 is met by the "tag" (reference numeral 1030) of Kiraly. However, the "tag" in Kiraly is not incorporated into a viewable image that is transmitted to the client computer. Instead, it is a small portion of information associated with a larger record of information on a server which identifies to a client computer a certain portion of the information on the server of interest to the client computer. It is not something that is sent to the client computer and it is not

something that is displayed on a display screen at the client computer.

Furthermore, there is nothing in Kiraly that corresponds with the "unique work identifier" of element (a) in claim 47. In Kiraly, the "identifier" in column 15 at line 19 identifies "the licensee" In Kiraly, the "licensee" is a person owning and operating a client computer. This identifier which identifies a computer or a person that owns or operates it does not meet the limitation of a "work" identifier of element (a) of claim 47.

As claim 47 is allowable over Kiraly, the claims which depend from it, 48-56, are also allowable.

Claim 57 stands rejected as anticipated by Kiraly. Claim 57 specifies a method for granting licenses to use one of a plurality of works of authorship and presenting records of said licenses. Element (a) of claim 57 specifies a server that presents web pages, each page associated with one of a plurality of source works of authorship. Although Kiraly discloses a method that involves the granting of a license, the system in Kiraly concerns only a single work of authorship, the intelligent assistant, rather than a plurality of works of authorship of which one is licensed. Kiraly associates his licenses to clients (aka licensees) (Col. 15, lines 17-19), but does not associate them to individual works of authorship selected from a plurality of works of authorship. Kiraly is identifying and licensing only a client, whereas Claim 57 specifies (identifying and) licensing a work of authorship from a plurality of works of authorship.

As claims 58 – 64 depend from claim 57, they are also allowable over Kiraly.

Claim 65 stands rejected under 102 as anticipated by Kiraly. It specifies a method for creating a registration for a publisher of a set of works of authorship, thereby generating a record on a server containing terms for licensing one or more of the works of authorship having an identifier associated with the publisher, and then including the identifier in subsequently published copies of works of authorship so that a person viewing one of the subsequently published works may use the identifier to access on

the server the terms for licensing the work. Although Kiraly and many other uncited references disclose that works of authorship might be published on a computer network, Kiraly does not suggest that an identifier might be included in published copies of works of authorship so that a person viewing the work might use the identifier to access on the network terms for licensing the work. In column 15, Kiraly discusses assigning an identifier to the licensee, not to the licensor or publisher of a work of authorship. The identifier discussed in Kiraly is not published to anyone, let alone as an inclusion in subsequently published copies of works of authorship.

Claims 66 – 68 depend from claim 65 and are therefore allowable over Kiraly.

Claim 77 stands rejected as anticipated by Kiraly. Claim 77 corresponds with claim 57. Claim 77 is allowable over Kiraly for the same reasons as discussed above for claim 57.

Claims 78 – 80 depend from 77 and are therefore allowable over Kiraly.

Claim 81 stands rejected as anticipated by Kiraly. Claim 81 corresponds with claim 65 and is allowable over Kiraly for the same reasons as discussed above for claim 65.

Claim 72 stands rejected as anticipated by Stefik. Stefik teaches away from the invention of claim 72. Claim 72 specifies that licensing terms are stored in a record on a server rather than being attached to a copy of a work of authorship. By contrast, Stefik specifies in many places that an essential aspect of his system is that usage rights ("licensing terms") are combined with content in each digital copy of a work of authorship. For this reason, the system of Stefik has no need for the invention of claim 72. In Stefik, any person who obtains a copy of a work of authorship can simply look within the digital contents of the document to determine the licensing terms. By contrast, claim 72 specifies that for a set of works of authorships, a "code"

corresponding to the licensing terms record is generated. This code is then used by other parties to access the server via a second client computer system to access the licensing terms record. Stefik makes no mention of such a code because is unnecessary in Stefik.

Claims 73 – 76 depend from claim 72 and are therefore allowable over Stefik.

Claim 69 stands rejected under §103 as unpatentable over Kiraly in view of Shi. The fifth element of claim 69 specifies that an identifier for a publisher's set of works of authorship is included in published copies of the works of authorship so that a person viewing one of the works may access terms for licensing the work. Although Kiraly discloses that a single work of authorship might be licensed, Kiraly does not disclose or suggest that an identifier might be included in a work of authorship so that a person viewing the work may use the identifier to access terms for licensing the work. The identifier mentioned in Kiraly is an identifier of the licensee not an identifier of the work of authorship, and this identifier is not included in the work of authorship so that licensing information may be viewed by others. While Shi discloses a system in which an identifier is sent from a server system to a client system, this is an identifier that identifies the client's system, not an identifier that identifies a work of authorship. Furthermore, the identifier in Shi is not included in a published copy of a work of authorship so that others viewing the work may access terms for licensing. The Examiner asserts that would have been obvious to include Shi's client identifier in subsequently published copies of works of authorship so that a person viewing one of the works may access terms for licensing the work. However, this assertion is entirely unsupported and unworkable. The identifier referred to in Shi is a "persistent client state object", (aka cookie), but in Fig 4, items 81 and 84, we see that they are routinely destroyed and new (i.e. different) ones are made. Therefore, should the user cause the

destruction of their cookie in Shi (say, by logging out or otherwise ending their session and then starting a new session, possibly on a different computer), a new cookie would be generated and used. So to include these client identifiers in subsequent works of authorship would be unworkable and nonsensical, as they would need to be continually updated whenever the client's cookie changed.

Claims 70 and 71 depend from claim 69 and are therefore also allowable.

As discussed above, all of the pending claims are allowable over the cited prior art. Applicant requests a promptly issued notice of allowance.

DATED this 12TH day of March, 2002.

Respectfully submitted,

GRAYBEAL JACKSON HALEY LLP

By _____

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Enclosures: Declaration and Certificate of Mailing

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mike O'Donnell and Andrew Cameron

Serial No.: 09/245,798

Filing Date: February 5, 1999

Title: AUTOMATED LICENSING AND ACCESS TO GRANTED LICENSES FOR WORKS OF AUTHORSHIP

Attorney Docket No.: 1690-1-1

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited in the United States Postal Service as First Class mail in an envelope addressed to: Assistant Commissioner for Patents, Box MISSING PARTS, Washington, D.C. 20231, on this 26th day of April, 1999.

Signature

RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

In response to the Notice to File Missing Parts of Application dated February 26, 1999, Applicant submits:

__X__ 1. An executed Combined Declaration and Power of Attorney in the above identified U.S. patent application.

__X__ 2. A copy of the NOTICE TO FILE MISSING PARTS OF APPLICATION.

__X__ 3. An assignment, recordation sheet, and $40 check has been sent under separate cover to BOX ASSIGNMENTS

FEE COMPUTATION

Surcharge Fee	$ 65.00
TOTAL:	$ 65.00

X 4. Check No. 13676 for surcharge fees.

X 5. Please charge any additional fees or credit any overpayment to Deposit Account No. 07-1897.

Respectfully submitted,

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#11/Petition
4/4/02

DECLARATION AND POWER OF ATTORNEY IN PATENT APPLICATION

COPY OF PAPERS ORIGINALLY FILED

Attorney Docket No. 1690-1-1

As the below named inventors, we hereby declare:

My residence, post office address and citizenship are as stated below next to my name.

I believe that I am the original, first and sole inventor (if only one name is listed below) or a joint inventor (if plural inventors are listed below) of the subject matter that is claimed and for which a patent is sought on the invention entitled:

AUTOMATED LICENSING AND ACCESS TO GRANTED LICENSES FOR WORKS OF AUTHORSHIP

the specification of which

☐ was filed on February 5, 1999 as U.S. Application Serial No. 09/245,798

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b), of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT international application designating at least one country other than the United States listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s):

Number	Country	Date Filed	Priority Claimed
		Day/Mo/Year	Yes/No
		Day/Mo/Year	Yes/No

I hereby claim the benefit under Title 35, United States Code Section 119(e) of any United States provisional application(s) listed below.

Application No.	Filing Date

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s), or Section 365(c) of any PCT international application designating the United States listed below, and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56, which became available between the filing date of the prior application and the national or PCT international filing date of this application.

Application Number	Filing Date	Status: Patented Pending/Abandoned

I hereby appoint the attorneys associated with Customer No. 000996 to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith.

Address all correspondence and phone calls to:

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I hereby further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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